

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) 2002P12810WOUS																
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on _____</p> <p>Signature _____</p> <p>Typed or printed name _____</p>		<table border="1"> <tr> <td>Application Number 10/529,334</td> <td>Filed 2005-03-24</td> </tr> <tr> <td colspan="2">First Named Inventor Werner Lindemann</td> </tr> <tr> <td>Art Unit 2444</td> <td>Examiner Muktesh G. Gupta</td> </tr> </table>	Application Number 10/529,334	Filed 2005-03-24	First Named Inventor Werner Lindemann		Art Unit 2444	Examiner Muktesh G. Gupta										
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<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>																		
<p>I am the</p> <table> <tr> <td><input type="checkbox"/> applicant/inventor.</td> <td>/Ralph G. Fischer/</td> </tr> <tr> <td><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td> <td>Signature</td> </tr> <tr> <td><input type="checkbox"/> attorney or agent of record. Registration number _____.</td> <td>Ralph G. Fischer</td> </tr> <tr> <td></td> <td>Typed or printed name</td> </tr> <tr> <td></td> <td>412-392-2121</td> </tr> <tr> <td></td> <td>Telephone number</td> </tr> <tr> <td><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td> <td>2010-06-02</td> </tr> <tr> <td></td> <td>Date</td> </tr> </table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			<input type="checkbox"/> applicant/inventor.	/Ralph G. Fischer/	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Signature	<input type="checkbox"/> attorney or agent of record. Registration number _____.	Ralph G. Fischer		Typed or printed name		412-392-2121		Telephone number	<input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	2010-06-02		Date
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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## I. RESPONSE TO THE REJECTION OF CLAIMS 14-35

The Examiner rejected claims 14-28 and 32-35 as anticipated under 35 U.S.C. § 102 in view of U.S. Patent Application Publication No. 2003/0236916 to Adcox et al. in the Office Action dated February 2, 2010 (hereafter "Office Action"). Claims 29-31 were rejected as obvious in view of Adcox et al. (Office Action, at 27).

### A Adcox et al. Is Not Prior Art

The Adcox et al. reference was filed on April 21, 2003. This filing date is after the priority date of the present application, which is September 25, 2002.

The Adcox et al. claims priority to a provisional patent application no. 60/374,690. A copy of this provisional patent application is attached. That application contains two pages of text and includes a 57 page document describing a prior art system. That document appears to be a previously filed patent application that lists five different inventors (none of which are Mr. Adcox) and does not disclose the invention nor provide any drawings for the invention identified in the specification of the provisional application.

For the Examiner's reference, a copy of the provisional patent application no. 60/374,690 was provided with the Request for Reconsideration dated March 8, 2010. Of course, the Examiner may also access the contents of this application electronically as well.

"The 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications and certain international application publications entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application **with certain exceptions if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph.**" MPEP § 2136.03 (emphasis added); *see also* MPEP § 706.02(f)(1).

The text cited by the Examiner in the cited published patent application of Adcock et al. is not accorded the filing date of the provisional patent application from which it claims priority. All the paragraphs relied upon by the Examiner as teaching or suggesting a claimed limitation are not present in the provisional application no. 60/374,690. For example, Adcox et al. disclose a OEC. The OEC has a MAC address and alters a serial portion to point to the OEC host table entry for the source MAC address. There is no disclosure of any OEC that is connected to a first network element and sets up any connection between a first network element and an external device. Nor is there any teaching or suggestion of any device that establishes a temporarily transparent connection between the first network element and the external device. Nor is there a disclosure of any unique address of the first network element that is valid for the external device being transferred to the external device. Indeed, the provisional application does not teach or suggest any transfer of any unique address from a network element to an external device. The provisional application merely suggests that headers in messages should be translated.

The provisional application only names one inventor, Timothy Adcox, but the Adcox et al. reference names multiple inventors. The naming of additional inventors indicates that new matter contributed by the additional inventors is present in the cited published application that is not in the provisional application.

**B. Claims 14-27, 32 And 34 Are Allowable**

Claim 14 requires a network node device to utilize a method that sets up a connection between a first network element and an external device. The connection is set up such that the unique address of the first network element is converted to an address valid for the external device. If the network node device determines that a message header entry characterize an expanded packet-oriented protocol, it establishes a temporarily transparent connection between

the first network element and the external device. The unique address of the first network element that is valid for the external device is transferred to the external device without converting that address for the duration of the temporarily transparent connection. Claims 15-27, 32 and 34 depend directly or indirectly from claim 14 and also contain these limitations.

Even if Adcox et al. is improperly applied as prior art, Adcox et al. do not render claims 15-27, 32 or 34 unpatentable. Adcox et al. disclose a MAC layer translation system that has a home network unit coupled to a passive optical network. Upon receiving an outgoing transmission from a host system that includes a host MAC layer address, the home network unit accesses a MAC address table to determine a secondary MAC layer address associated with the host MAC layer address and modifies the outgoing transmission to replace the host MAC layer address with the secondary MAC layer address. (Adcox et al., Abstract).

Adcox et al. do not teach or suggest any unique address of the first network element that is valid for the external device being transferred to the external device without converting that address for the duration of the temporarily transparent connection. To the contrary, Adcox et al. teach that all outgoing messages to external devices are replaced with a different address. (Abstract; *see also ¶¶ 118-19*).

#### **C. Claims 28-31, 33 And 35 Are Allowable Over Adcox et al.**

Claim 28 requires a network node element for supporting a transparent exchange of data packets to include at least one first network interface configured to connect to a packet-oriented network, at least one second network interface configured to connect to an external device, and at least one monitoring unit operatively connected to at least one of the at least one first network interface and the at least one second network interface. The at least one monitoring unit is configured to establish a temporarily transparent connection between at least one network

element of the packet-oriented network and the external device. The network node element is also configured to not convert a unique address of any network element that is allocated to that network element by the external device for a duration of a temporarily transparent connection established between that network element and the external device. Claims 29-31, 33 and 35 depend directly or indirectly from claim 28 and also contain these limitations.

As discussed above, even if the Adcox et al. reference is improperly applied as prior art by the Examiner, there is no teaching or suggestion of any network node element configured to not convert a unique address of any network element that is allocated to that network element by the external device for a duration of a temporarily transparent connection established between that network element and the external device. In fact, Adcox et al. teaches away from such a limitation. (Abstract; ¶¶ 118-119).

**D. EP Patent No. 1 543 670 B1 Shows The Pending Claims Are Allowable**

The present application corresponds to granted European Patent No. EP 1 543 670 B1. A copy of this patent is provided with the Amendment dated October 8, 2009. The European Patent Office has found the invention disclosed in the present application to warrant patent protection. This is an indicia of the non-obvious nature of the pending claims and shows that the claims should be allowed.

**CONCLUSION**

For at least the above reasons, reconsideration and allowance of all pending claims are respectfully requested.